

REMARKS

In the Office Action, the Examiner rejected Claims 1-4, 6, 8-11, 13-17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Brandon in view of Mirville et al. Claims 5, 7, 12, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon in view of Mirville et al. and further in view of Levine. In response to prior Office Actions, Applicants have explained why the proposed combinations cited by the Examiner are improper, and Applicants continue to believe that the proposed combinations are improper. However, for purposes of responding to the pending rejections, even assuming that the combinations are proper, the pending claims are patentable over the cited combinations for at least the following reasons.

In rejecting Claims 1-4, 6, 8-11, 13-17, and 19, the examiner relies upon Mirville et al. only for its description that dialing some form of activation code can allow a caller to invoke a speed dialing feature. For all of the other limitation recited in Claims 1-4, 6, 8-11, 13-17, and 19, the examiner asserts that they are either disclosed in Brandon or obvious to add to the system disclosed in Brandon. However, when the limitations actually recited in these claims are compared with the actual disclosure of Brandon and Mirville et al. it is clear that even if the disclosures could somehow be combined, they do not yield all of the limitations recited in Claims 1-4, 6, 8-11, 13-17, and 19, and cannot be further modified as suggested by the examiner to yield all such limitations.

Claims 1, 8, and 14 all recite systems or methods that involve: (i) receiving a dialed service code from a calling party; and (ii) upon receiving the dialed service code, using a telephone network element that is disposed in a publicly switched telephone network to retrieve a list of parties previously called by the calling party. In rejecting these claims, the examiner asserts that Mirville et al. discloses that a caller using a telephone can dial a service code to access a speed dial feature, but the examiner fails to explain how this disclosure is relevant to the pending claims and also fails to explain how that feature can supposedly be incorporated into the system disclosed in Brandon.

When the disclosure of Brandon is examined it is clear that this feature cannot be incorporated into the system disclosed in Brandon to render the pending claims invalid.

As applicants have previously noted, the system described in Brandon is a stand alone device that includes an automated telephone directory. More importantly, Brandon discloses two different methods of placing a telephone call, neither of which involves accessing a list of previously called parties by dialing any type of code or telephone number. The first way is to lift the handset and dial the actual telephone number of the called party. (Col. 5, lines 59-60.) In that example, a list of previously called parties is *not* retrieved. (Col. 5, lines 59-60.) The second way involves: (1) selecting a database using a directory selector key pad that is actually part of the stand alone device; (2) selecting a page from the database using a page browser or a key pad that is actually part of the stand alone device to spell out the beginning of a name; (3) selecting a record using pointer keys that are actually part of the stand alone device; and (4) depressing the “CALL” key, which is actually part of the stand alone device. (Col. 6, lines 1-7).

Thus, Brandon does not disclose any form of remote access to the stored records, and instead, teaches the exact opposite – using the stand alone device itself to access the stored records. There is no other way of accessing these records disclosed in Brandon. Therefore, even if the feature of Mirville et al. that allows a caller to access a speed dialing feature by dialing an access code could be incorporated into the device disclosed in Brandon, there is nothing in either of these references that discloses, teaches, or even suggests that such a system would be operable to allow access to the records stored in the stand alone device. For example, while Brandon does disclose a DTMF generator, it does not disclose that it has the capability of receiving and deciphering any of the remotely transmitted codes disclosed in Mirville et al. Indeed, Brandon has no need for this capability because it receives all input from devices that are part of the stand alone device. Accordingly, Claims 1, 8, and 14, as well as all dependent claims, are patentable over the proposed

combination for at least these reasons.

Moreover, the examiner has conceded that even if the teachings of Brandon and Mirville et al. could be combined, that combination fails to expressly disclose the following elements: (i) upon receiving a dialed service code, using a telephone network element that is disposed in a publicly switched telephone network to retrieve a list of parties previously called by the calling party; (ii) generating an audio message based on the list; (iii) communicating the audio message to the calling party.

To overcome the deficiency regarding the failure of either reference to disclose generating an audio message based on a list of parties previously called by the calling party and communicating the audio message to the calling party, the examiner asserts that choosing whether an outgoing call list is to be presented visually or via audio messaging is merely an issue of design preference. Applicants take issue with several portions of this statement. Brandon does not disclose generating audio messages of any sort. To the contrary, Brandon only discloses displaying information obtained from stored records to a user via the display screen. While Brandon does disclose a speaker for use as a traditional speaker phone, Brandon clearly states that audio transmissions involving the speaker are not controlled by the CPU (the device that accesses the stored records). (Col. 2, lines 63-67). Thus, Brandon fails to disclose that there is any interaction between the CPU, which accesses the stored records, and the speaker, and as a result, fails to disclose that the information in the stored records can be converted audio messages and transmitted to a calling party. There is simply nothing in Brandon that discloses, teaches, or even suggests that the system disclosed in Brandon would be operable to generate audio messages and transmit them to a calling party as the examiner asserts. Accordingly, Claims 1, 8, and 14, as well as all dependent claims, are patentable over the proposed combination for at least these reasons as well.

With respect to Claims 2, 9, and 15, neither Brandon nor Mirville et al. discloses

communicating an audio message to a calling party where the audio message comprises a plurality of telephone numbers of parties previously called by the calling party. Accordingly, these claims are patentable over the proposed combination for this reason as well.

With respect to Claims 3, 10, and 16, neither Brandon nor Mirville et al. discloses communicating an audio message to a calling party where the audio message comprises a plurality of names of parties previously called by the calling party. Accordingly, these claims are patentable over the proposed combination for this reason as well.

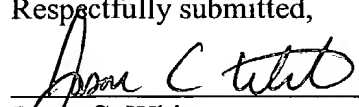
With respect to Claim 7, it recites, among other things: (i) receiving a personal identification number from the calling party; (ii) generating a first audio message based on a first portion of a list of parties previously called by the calling party, where the first audio message comprises a first plurality of names of parties previously called by the calling party; (iii) communicating the first audio message to the calling party; (iv) generating a second audio message based on a second portion of the list, where the second audio message comprises a second plurality of names of parties previously called by the calling party; and (v) communicating the second audio message to the calling party. Neither Brandon nor Mirville et al. disclose these features.

As noted above, while Brandon does disclose that a calling party can use a key pad to access a database that includes records of information about people (col. 6, lines 1-6), Brandon does not disclose generating an audio message that is based upon a list of parties previously called by the calling party or communicating the audio message to the calling party. Indeed, Brandon does not disclose that any audio messages are generated or communicated to a calling party as recited in these claims. Moreover, Brandon does not disclose receiving a personal identification number from a calling party. Accordingly, Brandon does not disclose any of the five features enumerated in the paragraph above. Likewise, Mirville et al. fails to disclose these features. Accordingly, Claim 7 is

patentable over the proposed combination for at least these reasons.

In view of the above remarks, Applicants submit that this case is in condition for allowance. If the Examiner feels that a telephone interview would be helpful in resolving any remaining issues, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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